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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Shawn P. Delany

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05/03/2006

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EXAMINER

CORRIELUS, JEAN M

ART UNIT

PAPER NUMBER

2162

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/997,409

Applicant(s)

DELANY ET AL.

Examiner

Jean M. Corrielus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-33 and 36-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-33, 36-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This office action is in response to the request for consideration filed on February 7, 2006, in which claims 1, 2, 5-22, 25-33 and 36-43 are presented for further examination.

### ***Response to Arguments***

2. Applicant's arguments filed on February 7, 2006 have been fully considered but they are not persuasive. (See examiner's remark).

### ***Remark***

(A). Applicants asserted that the 101 rejection in the last office action is improper. The examiner disagrees with precedent assertion. It is noted, however, that claim 1 directed to non-statutory subject matter. The method as claimed does not embody in the computer readable medium. Actually, no post computer process activity is found in the technological arts. The method as claimed is not a physical transformation. Thus, no physical transformation is performed, no practical application is found in the claims. Such modification entries as claimed can be done in a piece of paper, where one having ordinary skill in the art would produce a random number a data record and compare that random number with the previously random number in the sheet. Also, the claims do not appear to correspond to a specific machine or manufacture disclosed within the specification and thus encompass any product of the class configured in any manner to perform the underlying process, and are thus rejected as being directed. Claim 1, 2 and 5-21 are not **tangibly embodied** in a manner so as to be executable as the only hardware is in an intended use statement. Therefore, claims 1, 2 and 5-21 are directed to

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an abstract idea that is not tied to a environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. Applicants were advised to amend the claims by specifying the claim being directed to a practical application and producing a tangible result and **embodied** in a manner so as to be executable as the only hardware is in an intended use statement.

(B). Applicants asserted that the examiner has failed to establish a prima facie case of obviousness under 35 U.S.C 103 by not showing (1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art; (2) a reasonable expectation of success; and (3) the combined prior art references teach or suggest all the claim limitations. The examiner disagrees with the precedent assertion. It is important, Applicants are interpreting the claims very narrow without considering the broad teachings of the reference used in the rejection. In the last office action, the examiner went through the claims phrase by phrase and referred to the prior art columns and line numbers as to where the examiner has drawn the correspondences between applicants' claims limitations and prior art. By failing to address these correspondences, Applicants have failed to rebut the examiner's prima facie case of obviousness uses for a different purpose which does not alter the conclusion that its use in a prior art device would be prima facie obvious from the purpose disclosed in the reference.

(i). The cited references do not teach or suggest, alone or in combination, removing auxiliary classes that are superior to a first auxiliary class (page 12). In response to Applicants' arguments that there is no appropriate motivation to combine Madam and Pinard, the examiner

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respectfully submits that Applicant misinterprets the references used in the rejection. The Court, In re Fritch, stated “the examiner can satisfy the above mentioned assertion only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”. In re fine, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (Citing In re Lalu, 747, F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988). Each applied reference does not expressly suggest combination with the other respective references. The motivation referred to In re Fritch involves extensive changes to the primary references.

Applicants are reminded that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. Furthermore, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya USPQ 607 (CCPA 1975). On the other hand, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969. The examiner respectfully submits that Pinard discloses the claimed “removing auxiliary classes that are superior to a first auxiliary class” (see Pinard’s col.5, lines 11-16 and col.6, lines 51-67). Thus, one having ordinary skill in the art would have found it obvious to combine the teachings of the cited

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references by incorporate the use of “removing auxiliary classes that are superior to a first auxiliary class” in the system disclosed by Madan in the same conventional manner as disclosed by Pinard (col.5, lines 11-16 and col.6, lines 51-67). One having ordinary skill in the art would have found it motivated to enable the system provide the program disclosed by Madan to remove unwanted class of items and the database tables relating to that class of items, thereby preventing the removing class to appear on the parent web page. Desgranges was introduced to teach the absence claimed limitation from Madan and Pinard. So, Desgranges discloses the claimed “removing a subset of said first set of attributes includes the use of identifying a set of auxiliary classes in a user interface (col.6, lines 66-67; col.7, lines 10-22); receiving a selection of one or more of said auxiliary classes via said user interface (col.6, lines 66-67; col.7, lines 1-10).

(i). It is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time the invention that support a holding of obviousness has been adequately provided by the motivations given by the examiner in the prior office action. Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93), specially every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. Applicants are reminded that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. Furthermore, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya USPQ 607 (CCPA 1975).

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(ii). It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

(iii). As per Applicants' arguments that all claim limitations be taught or suggested by the prior art, Applicants appear to misinterpret the guidance given under MPEP 2142. In particular, references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA) 1969.

There are numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1596, 1598 (Fed. Cir. 1988) (Citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined *In re Lamberti et al.*, 192 USPQ 278 (CCPA) that:

- (a) obviousness does not require absolute predictability;
  - (b) non-preferred embodiments of prior art must also be considered; and
  - (c) the question is not express teaching of references, but what they would suggest.
- (B). According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement, that which is disclosed therein.

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Furthermore, the skilled artisan would not consider the prior art embodiments in a vacuum, but would have had the motivation to combine the advantageous features of the prior art in the manner purported by the examiner for the reasons and motivations given above as well as in the prior office action. Thus the combined teachings of Madan, Pinard and Desgranges when considered as a whole to one of ordinary skill in the art make obvious that Applicants dispute.

### ***Conclusion***

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

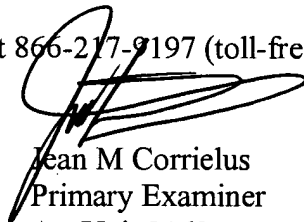
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean M. Corrielus whose telephone number is (571) 272-4032. The examiner can normally be reached on 10 hours shift.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jean M Corrielus  
Primary Examiner  
Art Unit 2162

April 26, 2006